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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,216	12/22/1999	DALE F. MCINTYRE	80121F-P	5901

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EXAMINER

POND, ROBERT M

ART UNIT PAPER NUMBER

3625

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/470,216

Applicant(s)

MCINTYRE ET AL. 

Examiner

Robert M. Pond

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16, 77 and 78 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16, 77 and 78 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Claims 1-16, 77, and 78 in the reply filed on 28 July 2004 is acknowledged.

### ***Response to Amendment***

The Applicant canceled non-elected Claims 17-76. The Applicant amended Claims 1 and 10, and newly added Claims 77 and 78. All pending claims (1-16, 77, and 78) were examined in this final Office Action.

### ***Response to Arguments***

#### **Rejection under 35 USC 112**

Applicant's arguments, see Remarks filed 20 April, with respect to rejection under 35 USC 112 have been fully considered and are persuasive. Rejection of Claims 10 and 11 under 35 USC 112 has been withdrawn.

#### **Rejection under 35 USC 102(b)**

Applicant's arguments filed 20 April 2004 have been fully considered but they are not persuasive. Pertaining to Claims 1, 3-6, 8, 10-13, and 15, the Applicant argues there is no teaching or suggestion of providing goods or services upon reaching a predetermined criteria, and bases arguments on the 4<sup>th</sup> page of the cited reference (Photonet) as teaching away from the invention.

The Examiner specifically cites on page 4 of the Office Action, Photonet disclosing automatically providing a product to a customer (e.g. customer receiving physical prints, accessing by the customer processed digital images stored in an online database, a customer receiving a floppy disk containing a number of digital images). As cited on page 5 of the Office Action, the customer receives the floppy disc from the service provider after a predetermined criteria is reached. In this case, predetermined criteria are established by the maximum number of expose images of a roll of film submitted by the customer (e.g. 12, 24, 36). The Office Action cites this specifically and does not rely upon the 4<sup>th</sup> page of the cited reference discussing how long the photos are kept online (30 days), and therefore does not teach away. Furthermore, Photonet teaches Photonet as an archival service for digital images that can be stored up to 100 years. This disclosure provides evidence the 30-day free-of-charge limitation of the archival service is a business decision by the service provider.

The Examiner maintains the position that Photonet teaches the customer automatically receiving a product back containing digital images on portable storage medium from the service provider once predetermined criteria is met.

Rejection under 35 USC 103(a)

Applicant's arguments filed 20 April 2004 have been fully considered but they are not persuasive.

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- Pertaining to Claim 2, the Applicant argues Claim 2 is dependent upon independent Claim 1 and is therefore patentably distinct for the same reasons previously discussed.

The Examiner respectfully disagrees with the Applicant for the reasons noted above.

- Pertaining to Claim 2, the Applicant argues Florida Times Report is nothing more than a further elaboration of the PhotoNet system and IPR discloses check archiving system.

Photonet teaches the Photonet service as an archival service and archiving digital images over a period of time. Florida Times Report may be a further elaboration on Photonet but teaches Photonet's competitor, Fuji Photo Films Fujifilm.net offering the option of having pictures scanned and transferred to a floppy disk or compact disk, and therefore establishes high capacity compact disk as an option for storing digital images on a portable medium for archival purposes. IPR provides a pertinent teaching on how compact disk is used to archive digital images (e.g. digital images of check) using time as predetermined criteria. The Applicant's arguments pertaining to IPR place emphasis on the teachings pertaining to checks. The point of IPR is about the use of a portable storage medium such as compact disk to deliver a product containing digital images to a customer once predetermined time criteria is met. Photonet, Florida Times Report,

and IPR teach archiving digital images on storage media, specifically a compact disk, using time as predetermined criteria.

- Pertaining to Claims 7, 9, and 16, the Applicant argues these claims are dependent upon independent Claims 1 and 10 and are therefore patentably distinct for the same reasons previously discussed.

The Examiner respectfully disagrees with the Applicant for the reasons noted above.

Newly Added Claims 77 and 78

Applicant's arguments filed 20 April 2004 have been fully considered but they are not persuasive.

- The Applicant argues the Photonet service does not teach or suggest the establishment of the predetermined criteria.

The Examiner respectfully disagrees with the Applicant for the reasons noted above.

- Goods can be sent to any designated party.

Photonet teaches other parties receiving the goods other than the customer.

Official Notice (regarding photo albums)

The Applicant did not traverse the examiner's assertion of official notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 1. Claims 1, 3-6, 8, 10-13, and 15 are rejected under 35 USC 102(b) based upon a public use or sale of the invention.**

PhotoNet (Paper #14, PTO-892, Item: U) teaches all the limitations of Claims 1, 3-6, 8, 10-13, and 15. For example, PhotoNet discloses a system and method that allows online users to access a web site (www.photonet.com), store, view, organize, share, and download a plurality of images obtained from rolls of photographic film forwarded to photofinishers for processing (Item: see pages 1-17). PhotoNet further discloses:

- Database: Storing digital images on large servers (Item: U, see at least pages 1 and 4); Archive images for up to 100 years (Item: U, page 7).
- Digital images associated with customer account: Customer submitting a roll of film to a PhotoNet retailer for processing, customer requesting PhotoNet services, customer picking up processed roll of film (e.g. prints) from the retailer, receiving film ID (also referred to as a personal access code, one film ID per roll) to access the customer's online photos (Item: U, see at least pages 1 ("Login to View Your Photos"), 3-4, 8, and 17).

- Automatically providing a product: Customer automatically receiving an e-mail message when the product order is ready to be picked up (Item: U, see at least pages 3-4); Customer automatically receiving both a physical product (prints) and electronic product (digital images) if PhotoNet services are checked prior to the system receiving the film for processing (Item: U, page 3-4); Customer automatically receiving a floppy diskette product (PhotoNet Disk) containing an entire roll of digital images if checked (Item: U, page 16).
- Delivery to a recipient designated by customer: Customer submitting a roll of film for processing designates a recipient for prints and provides an email address of intended recipient of product; Customer designating an email recipient and sends online photos to the intended recipient (Item: U, pages 5, 14, and 17).
- After pre-determined criteria (number of images): Customer submitting a roll of film with one or more exposed images for processing (pre-determined prior to receipt of digital images), the roll having a pre-determined number of exposable images (Item: U, see at least pages 3-4) (please note examiner's interpretation based on disclosure as noted above regarding PhotoNet Disk: customer receives PhotoNet Disk after pre-determined number of digital images are stored on the disk up to a maximum number of exposures contained on the roll).



- Pre-determined criteria (providing product based on time): Processing the film the day the film is received, the recipient receiving an e-mail message; mailing back prints to the recipient the same day (Item: U, see at least page 10).
- Image scans: PhotoNet retailers producing high resolution image scans; Customer selecting "Scan to Internet" option (Item: U, see at least pages 6 and 9).
- System management: Online PhotoCenter managing a web site for Internet users to access their digital images stored on large servers in multiple locations connected to the Internet; uses Netscape servers to provide World Wide Web access (Item: U, see at least pages 1 and 4).
- Development center: Development center processes film (Item: U, see at least page 8).
- Fulfillment: Producing a diskette containing the customer's digital images obtained from a processed roll of film, and providing the physical product to the customer (Item: U, page 16).
- Electronic album: Providing at least one album page containing digital images (Item: U, see at least page 8).
- Film role ID: Providing a unique identification code for each roll of processed film submitted by the customer (Item: U, see at least page 8).
- Grouping IDs: Grouping online rolls to "make them easy to find" (Item: U, page 17) (please note interpretation by examiner's example: a customer

has four rolls of film processed and receives a unique film ID for each roll.

The act of combining all four rolls creates a group; the act of combining two or three rolls together creates subgroups from the possible group of four rolls).

- Sharing digital images with a third-party: Customer sharing images with a third-party (e.g. friend, family member) by selecting images and sending intended recipient an e-mail containing attached digital images (Item: U, pages 4-5, 9, 14, and 17).
- Third-party access to account: providing a third-party the access code so they may view digital images (Item: U, pages 4-5, 9, 14, and 17).
- Online ordering: Friends and relatives ordering their own prints without using the customer as the intermediary (Item: U, page 6).
- Entering name and unique ID: Customer enters online name and film ID to view online photos (Item: U, pages 4 and 8).
- Entering customer information online: name, access codes (Item: U, see at least pages 8-10, and 14).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 2, 77, and 78 are rejected under 35 USC 103(a) as being unpatentable over PhotoNet (Paper #14, PTO-892, Item: U), in view of Florida Times Union (Paper #12, PTO-892, Item: U), as applied to Claim 1, further in view of Item Processing Report (Paper #14, PTO-892, Item: UU, hereinafter referred to as "IPR").**

PhotoNet teaches all the above as noted under the 102(b) rejection and further teaches providing a customer with their digital images on a floppy disk, but do not disclose providing a compact disk (CD). Florida Times Union teaches Kodak's web-based online photo service Photonet ([www.kodak.photonet.com](http://www.kodak.photonet.com)) competing against archrival Fuji Photo Film's Fujifilm.net ([www.fujifilm.net](http://www.fujifilm.net)). Florida Times Union further teaches many film processors offering the option of having pictures scanned and transferred to a floppy disk or compact disk (Paper #12, PTO-892, Item: U, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of PhotoNet to provide digital images on a compact disk as taught by

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Florida Times Union, in order to provide an alternative to floppy disk storage, and thereby attract customers to the service.

PhotoNet and Florida Times Union teach all the above as noted under the 103(a) rejection and teach storing digital images scanned from a roll of film onto a compact disk during a time period predetermined by the system, but do not disclose a predetermined criteria comprising a predetermined time period. IPR teaches storing digital images onto compact disk, and further teach the "customer can receive their digital images on a daily, weekly, or monthly compact disk." (Item: UU, see at least page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method PhotoNet and Florida Times Union to associate predetermined criteria comprising a time period as taught by IPR, in order to base goods and services on a predetermined time period, and thereby attract customers to the service.

- 3. Claims 7 and 9 are rejected under 35 USC 103(a) as being unpatentable over PhotoNet (Paper #14, PTO-892, Item: U), in view of Bloom (Paper #14, PTO-892, Item: V).**

PhotoNet teaches all the above as noted under the 102(b) rejection but does not disclose automatically providing a subsequent roll of photographic film. Bloom teaches PhotoNet, digital photography, and companies competing against PhotoNet in online photo services. Bloom teaches Filmworks developing photographic film as slides, prints, or digital copies, offering competitive prices,

and optionally returning digitized pictures on a floppy disk instead of through the Internet. Bloom further teaches the company (Filmworks) sending a free roll of film with each roll it develops (Item: V, see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method PhotoNet to automatically provide a subsequent roll of film as taught by Bloom, in order to provide additional benefits to the customer, and thereby attract customers to the service.

PhotoNet teaches all the above as noted under the 102(b) rejection and further teaches downloading software used for editing digital images and uploading digital images, but do not disclose allowing the customer to modify at least one image prior to providing the product. Bloom teaches Sony's offering development and digitization services from its ImageStation service. Bloom teaches a user editing a digital image, submitting to ImageStation on PhotoNet and either receiving a physical product (prints) or electronic product (digital image) (Item: V, see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method PhotoNet to include image editing prior to receiving a product as taught by Bloom, in order to permit customers to enhance the quality of the photographic image before receiving a product, and thereby attract customers to the service.

- 4. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over PhotoNet (Paper #14, PTO-892, Item: U), in view of Florida Times Union (Paper #12, PTO-892, Item: U).**

PhotoNet teaches all the above as noted under the 102(b) rejection and further teaches providing a customer with their digital images on a floppy disk, but do not disclose providing a compact disk (CD). Florida Times Union teaches Kodak's web-based online photo service Photonet ([www.kodak.photonet.com](http://www.kodak.photonet.com)) competing against archrival Fuji Photo Film's Fujifilm.net ([www.fujifilm.net](http://www.fujifilm.net)). Florida Times Union further teaches many film processors offering the option of having pictures scanned and transferred to a floppy disk or compact disk (Paper #12, PTO-892, Item: U, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of PhotoNet to provide digital images on a compact disk as taught by Florida Times Union, in order to provide an alternative to floppy disk storage, and thereby attract customers to the service.

- 5. Claim 16 is rejected under 35 USC 103(a) as being unpatentable over PhotoNet (Paper #14, PTO-892, Item: U), in view Shiota et al. (Paper #6, patent number 6,324,521), as applied to Claim 10, further in view of Official Notice (Paper #14, regarding photo albums).**

PhotoNet teaches all the above as noted under the 102(b) rejection and teaches providing an online photo album displaying a plurality of digital images

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on a page, and further teaches providing online ordering of printed products (e.g. extra prints, photo gift items), but do not disclose providing a printed album page. Shiota et al. teach a network photographic service providing online storage of digital images and printing services. Shiota et al. further teach printing services that arrange ordered pictures in an album. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to disclose printed photo albums as taught by Shiota et al., in order to generate additional revenue from printed services.

PhotoNet and Shiota et al. teach all the above as noted under the 103(a) rejection and teach a plurality of printed pictures being arranged in a photo album but do not disclose a plurality of images on both sides of an album page. This examiner takes the position that it is old and well known that photo albums pages are designed for double-sided arrangements of pictures to maximize picture content for a given album. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to arrange printed pictures on both sides a photo album page as taught by Official Notice, in order to maximize the number of arranged pictures for a given album.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:



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or faxed to:

**703-872-9306** (Official communications; including After Final  
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is positioned above the printed name and title.

Robert M. Pond  
Patent Examiner  
October 14, 2004